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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/27/2003

John R. Klug

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DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
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SUITE 4700
DENVER, CO 80202-5647

EXAMINER

LAZARO, DAVID R

ART UNIT

PAPER NUMBER

2455

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/673,073	KLUG, JOHN R.	
	Examiner	Art Unit	
	DAVID LAZARO	2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-44 and 67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-44 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the RCE filed 10/27/08.
2. Claims 28 was amended.
3. Claims 1-27 and 59 are canceled.
4. Claims 45-58 and 60-66 are withdrawn
5. Claim 67 is newly added
6. Claims 28-44 and 67 are pending in this office action.

Response to Amendment

7. Applicant's arguments with respect to claims 28-44 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 28-44 and 67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
10. Claim 28 is directed towards a method for receiving and processing communications including various determining and processing steps. However, claim 28 does not appear to be tied to a statutory class nor transform the underlying subject matter. Therefore, the method is not a patent eligible process under 35 USC 101 and is

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directed towards non-statutory subject matter. The claim should positively recite the other statutory class to which it is tied, for example, by identifying the apparatus that accomplishes the determining and processing steps. Dependent claims 29-44 are similarly deficient.

11. Claim 67 is directed towards a method for receiving and processing communications including various determining and processing steps. However, claim 67 does not appear to be tied to a statutory class nor transform the underlying subject matter. Therefore, the method is not a patent eligible process under 35 USC 101 and is directed towards non-statutory subject matter. The claim should positively recite the other statutory class to which it is tied, for example, by identifying the apparatus that accomplishes the determining and processing steps.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 28-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0120705 by Schiavone et al. (Schiavone) in view of U.S. Patent 2004/0143650 by Wollowitz (Wollowitz).

14. With respect to claim 28, Schiavone teaches a computer-implemented method for receiving and processing communications according to a value, comprising:

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determining whether the communication is associated with a frank, the frank corresponding to a value (Page 2 [0017] - email is checked for priority information which may be in many forms and may have a value associated with it);

in response to determining the communication is not associated with a frank, processing the communication according to at least one default rule (Page 3 [0020]-[0021] - default priorities may be used or other information besides a specific priority indicator will be used for processing); otherwise

determining a class to which the frank corresponds (Page 2 [0017] and [0012]: priority information can be indicative of a class);

in response to determining the class to which the frank corresponds, processing the communication according to at least one class-based rule (Page 3 [0018] - message is handled based on class identified by priority - also see Page 4 [0030]).

Schiavone does not explicitly disclose the frank is purchased from a franking server maintaining at least one account associated with at least one user. Wollowitz teaches a franking server maintaining at least one account associated with at least one user that allows user to purchase a frank to be used and associated with a communication (Paragraph [124]).

It would have been obvious to one of ordinary skill in the art to use a franking server for purchasing franks as described in Wollowitz in the franking system disclosed by Schiavone. Using the known technique of a purchasing franks from a franking server maintaining a user account to provide the frank purchasing required by Schiavone would have been obvious to one of ordinary skill in the art.

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15. With respect to claim 29, Schiavone further teaches wherein the step of processing the communication comprises: determining whether the frank corresponds to a class which is less than a specified minimum class; and in response to determining the frank corresponds to a class which is less than a specified minimum class, discarding the communication (Page 4 [0030] - lowest priority class of message may be rejected and not delivered).

16. With respect to claim 30, Schiavone as combined further teaches the step of, in response to determining the frank corresponds to a class which is not less than a specified minimum class, transmitting the communication from a network node to a recipient system (Page 4 [0030] - classes of appropriate higher priority will be delivered).

17. With respect to claim 31, Schiavone as combined further teaches where the communication is transmitted by way of at least one Internet service provider (Page 2 [0014] - ISP can carry out the invention).

18. With respect to claim 33, Schiavone as combined further teaches wherein the step of processing the communication according to at least one class-based rule further comprises: determining whether the class is less than a specified minimum class; and in response to determining the class is less than a specified minimum service class, delaying delivery of the communication (Page 4 [0030] - delivery of lowest priority class of message may be delayed).

19. With respect to claim 34, Schiavone as combined further teaches wherein the step of processing the communication according to at least one class-based rule

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comprises: determining whether the class is less than a specified minimum class; and in response to determining the class is less than a specified minimum class, placing the communication in a recipient-specified location (page 1 [0007] - routing to junk folder).

20. With respect to claim 40, Schiavone as combined further teaches wherein the communication is an electronic mail (Page 2 [0012] email).

21. With respect to claim 42, Schiavone as combined further teaches receiving a second communication; determining whether the second communication includes a second frank (Page 2 [0017] - would apply to all communications); in response to determining the second communication does include a second frank, determining a second class to which the frank corresponds (Page 2 [0017] and [0012]: each communication is checked for priority information); and determining a display order for the first and second communications, the display order based on the first class and the second class (Page 4 [0030] - recipient will receive mail in an order that is both determined based on the time of the incoming communication and the respective classes of the incoming communications).

22. Claim 43 is rejected based on the same logic of claim 28.

23. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of Wollowitz and in further view of official notice.

24. With respect to claim 32, Schiavone in view of Wollowitz teaches all the limitations of claim 28, and further teaches that generally any type of rule can specify the processing for the message of any particular identified priority (Page 4 [0030]).

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Schiavone further teaches distinguishing between different levels of priority in terms of establishing a priority hierarchy and discarding communications based on differences in the priority levels (Page 4 [0030]).

Schiavone in view of Wollowitz does not explicitly teach that if a frank is determined to be of a class that is greater than a minimal class, then the communication is discarded. However, one skilled in the art would readily recognize that a ranking scheme can be reversed and still carry out the same functionality. For example, it is common knowledge that one could rank levels from 1-10 with either 1 meaning the lowest or least important, 10 being the highest, or reverse it and have 1 meaning the highest or most important and 10 being the lowest. It is essentially a matter of perspective in how one chooses to label the levels. The corresponding functionality of the meaning attached to the corresponding label remains the same.

As such, it would have been obvious to one of ordinary skill in the art to substitute one ranking scheme for another for the predictable result of message processing based on the actual meaning of the ranking.

25. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of Wollowitz and in further view of U.S. Patent 5,694,616 by Johnson et al. (Johnson).

26. With respect to claim 35, Schiavone in view of Wollowitz teaches determining whether the frank corresponds to a class greater than or equal to a specified minimal class (Page 4 [0040]).

Schiavone in view of Wollowitz does not explicitly disclose in response to determining the rank corresponds to a class greater than or equal to a specified minimum class, displaying at least a portion of the communication in a specified color. Johnson teaches that email messages that are determined to be of greater importance can be displayed in a specified color or with a particular icon (Col. 1 lines 34-42). This is done to reflect the important status of the message.

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of displaying a high priority message in a specified color as disclosed by Johnson to further improve the priority system of Schiavone in view of Wollowitz for the predictable result of reflecting the higher priority of a particular message.

27. Claim 36-39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of Wollowitz and in further view of U.S. Patent 6,393,464 by Dieterman (Dieterman).

28. With respect to claim 36, Schiavone in view of Wollowitz does not explicitly disclose determining whether a characteristic of a sender of the communication matches at least one entry on an approved list; and in response to determining the characteristic of the sender matches at least one entry on the approved list, ignoring the step of processing the communication according to at least one class-based rule.

Dieterman teaches determining if a characteristic of a sender of a communication matches information of an approved list (Col. 5 lines 24-35). If the sender is on the

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approved list, the message is delivered without any further processing. This allows for control of the delivery of electronic communications (Col. 3 lines 20-25).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of determining if the characteristic of a sender matches at least one entry on an approved list as taught by Dieterman, to improve the messaging system of Schiavone in view of Wollowitz for the predictable result of controlling delivery of electronic communications.

29. With respect to claim 37, Schiavone in view of Wollowitz further teaches wherein the characteristic of the sender is one of an electronic mail address, a name, or an Internet protocol address (In Dieterman: Col. 3 lines 55-65).

30. With respect to claim 38, Schiavone in view of Wollowitz teaches determining whether a characteristic of a sender of the communication matches at least one entry on an approved list; and in response to determining the characteristic of the sender matches at least one entry on the approved list, assigning a second class to the communication.

Dieterman teaches determining if a characteristic of a sender of a communication matches information of an approved list (Col. 5 lines 24-35). If the sender is on the approved list, the message is marked as not requiring approval. This allows for control of the delivery of electronic communications (Col. 3 lines 20-25).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of determining if the characteristic of a sender matches at least one entry on an approved list as taught by Dieterman, to improve the messaging system of

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Schiavone in view of Wollowitz for the predictable result of controlling delivery of electronic communications.

31. With respect to claim 39, Schiavone in view of Wollowitz further teaches wherein the step of processing the communication according to at least one class-based rule comprises applying the class-based rule to the higher class of the class and the second class (In Schiavone Page 3 [0018]-[0020]: trusted sender priority is ranked the highest and considered first).

32. Claim 44 is rejected based on the same logic of claim 39.

33. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of Wollowitz and in further view of U.S. Patent 6,301,608 by Rochkind (Rochkind).

34. With respect to claim 41, Schiavone in view of Wollowitz further teaches the invention generally applies to network communications (Page 2 [0012]).

Schiavone in view of Wollowitz does not explicitly disclose the communication is a telephone call.

Rochkind teaches a system that uses priority information to process communications (Col. 2 lines 28-33 and line 64 - Col. 3 line 16). Such communications includes telephone calls (Col. 3 line 56 - Col. 4 line 6).

Because both Schiavone in view of Wollowitz and Rochkind process communications based on priority information, it would have been obvious to one skilled in the art to substitute telephone calls as a network communication in order to achieve

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the predictable result of processing communication based on the priority information of the communication.

35. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 6,920,564 by Decuir (Decuir).

36. With respect to claim 67, Schiavone teaches a computer-implemented method for receiving and processing communications according to a value, comprising:

determining whether the communication is associated with a frank, the frank corresponding to a value (Page 2 [0017] - email is checked for priority information which may be in many forms and may have a value associated with it);

in response to determining the communication is not associated with a frank, processing the communication according to at least one default rule (Page 3 [0020]-[0021] - default priorities may be used or other information besides a specific priority indicator will be used for processing);

otherwise determining a class to which the frank corresponds wherein the class is indicative of a communication handling instruction (Page 2 [0017] and [0012]: priority information can be indicative of a class);

in response to determining the class to which the frank corresponds, processing the communication according to at least one class-based rule (Page 3 [0018] - message is handled based on class identified by priority - also see Page 4 [0030]).

Schiavone does not explicitly disclose the communication handling instruction chosen from a group comprising: a secure transmission instruction; a size-based

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instruction; an auto-forward permission; a security-based instruction; and a viewing certification. Decuir teaches email handling instructions can include secure transmission, forward permission, security based, and viewing certification (Col. 7 lines 6-30).

It would have been obvious to one of ordinary skill in the art to have the handling instructions of Schiavone include the handling instructions of Decuir. Using the known techniques of the handling instructions described by Decuir to provide further communication handling for controlling and managing communications as desired by Schiavone would have been obvious to one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID LAZARO whose telephone number is (571)272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Lazaro/
Primary Examiner, Art Unit 2455
12/20/08